

UNITED STATES DISTRICT COURT
DISTRICT OF MASSACHUSETTS

IN RE: COLUMBIA UNIVERSITY
PATENT LITIGATION

)
)
)
)

MDL NO. 1592

ORDER

WOLF, D.J.

October 7, 2004

It is hereby ORDERED that:

1. Columbia University's ("Columbia") emergency motion to dismiss for lack of subject matter jurisdiction (Docket No. 86) is taken under advisement. As Columbia's expanded covenant not to sue changed the focus of the October 6, 2004 hearing, the parties shall, by October 12, 2004, file supplemental submissions addressing any cases relevant to whether the allegation of prosecution laches changes the analysis of Spectronics Corp. v. H.B. Fuller Co., Inc., 940 F.2d 631 (Fed. Cir. 1991) with respect to the '275 patent and GAF Building Materials Corp. v. Elk Corp of Dallas, 90 F.3d 479 (Fed. Cir. 1996) with respect to the '159 application.¹

2. Columbia shall, by October 12, 2004, file a revised covenant not to sue that reflects the changes described in court at the October 6, 2004 hearing. If any of the plaintiffs believe that the covenant not to sue that Columbia files is inconsistent with the representations Columbia made in court, they shall

¹This supplemental briefing was not discussed in court on October 6, 2004.

respond to Columbia's submission by October 14, 2004.

3. Biogen, Inc. ("Biogen") shall, by October 7, 2004, file, under seal, the portion of the Patent and Trademark Office Record for the '159 patent which reflects the rejection of the '159 application and any subsequent activity.

4. Columbia shall, by October 11, 2004, file a status report regarding the '159 application.

5. Briefing on the parties' motions for summary judgment as to non-statutory double patenting is STAYED.

6. Amgen Inc. and Immunex Corporation's ("Amgen") motion for leave to obtain discovery from foreseeably unavailable witness Dr. Sol Goodgal (Docket No. 99) is ALLOWED. Amgen may conduct a deposition of Dr. Goodgal for up to seven hours by October 20, 2004.

7. Amgen's motion to compel Columbia to produce Dr. Louis Simonovitch for his deposition or in the alternative for entry of letters rogatory (Docket No. 122) is taken under advisement. Counsel for Columbia shall, by 10:00 a.m. on October 12, 2004, consult Dr. Siminovitch and report whether he is willing to testify, in Canada, for up to seven hours at a date of his convenience in the near future if Amgen and/or any other interested plaintiff compensates him for his participation at the rate he is now charging Columbia. Additionally, if this issue is not resolved, the parties shall supplement their submissions relating to Amgen's motion to compel Columbia to produce Dr.

Siminovitch by October 14, 2004.

8. As suggested by Columbia, the court is reserving judgment on its motion for additional time to complete the deposition of Dr. Bruce Dolnick (Docket No. 128).

9. The parties shall each order an expedited copy of the transcript of the October 6, 2004 hearing.

/s/ Mark L. Wolf
UNITED STATES DISTRICT JUDGE